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Dated: May 18, 2005

Signature: Rhea Amid

(Rhea Amid)

Patent

Docket No. 532212000623

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES
FOR DETECTING PARATHYROID
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER MPEP 724.02

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.56 and MPEP 724.02, the attention of the Patent and Trademark Office is hereby directed to the **SUBJECT TO PROTECTIVE ORDER** documents listed on the attached Form PTO/SB/08a/b. It is respectfully requested that the information be expressly considered during the prosecution of this application.

The document numbers 1-11 listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. These documents are from civil action number 02 CV 0046 B (JMA), *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, currently pending in the United States District Court for the Southern District of California.

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A copy of each document that is **SUBJECT TO PROTECTIVE ORDER** listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of __ is enclosed.
 - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of __ is enclosed.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Pursuant to MPEP § 2004.13, Applicant points out that Nichols Institute Diagnostics Inc. (Nichols) has sued the assignee of the present application, Scantibodies Laboratory, Inc. (Scantibodies) for alleged infringement of U.S. Patent No. 6,030,790 ('790 patent). The '790 patent was submitted and considered by the Examiner in the prosecution of the parent patents of the

present application, U.S. Patent No. 6,689,566 B1 (the '566 patent) and U.S. Patent No. 6,743,590 B1. The '790 patent was also submitted in the February 25, 2004 IDS (Reference No. 11) and considered by the Examiner in connection with the present application (*See* the January 24, 2005 Office Action). Applicant wishes to bring the Examiner's attention to the following:

- Rebuttal Expert Report of Joseph O. Falkinham, III, Ph.D. (Document No. 10 in the present Form PTO/SB/08a/b), in which prosecution of the '566 patent is discussed.

Applicant would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other

fees due in connection with the filing of this document to Deposit Account No. 03-1952
referencing 532212000623.

Dated: May 18, 2005

Respectfully submitted,

By 

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Substitute for form 1449/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT***(Use as many sheets as necessary)*

Sheet	1	of	1	Attorney Docket Number	532212000623
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Complete if Known

Application Number	10/617,489
Filing Date	July 10, 2003
First Named Inventor	Thomas L. CANTOR
Art Unit	1641
Examiner Name	C. Cheu
Attorney Docket Number	532212000623

NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER

Examiner Initials [*]	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	1.	Declaration of M. Andrew Woodmansee in Support of Motion for Summary Judgment Pursuant to 35 U.S.C. § 102(b) by Defendants Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc., filed February 25, 2003	
	2.	Declaration of Brigham A. Fordham in Support of Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed July 16, 2003	
	3.	Declaration of Peter R. Munson in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed September 18, 2003	
	4.	Declaration of M. Andrew Woodmansee in Support of Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed September 24, 2003	
	5.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion to Permit Service of its Supplemental Amended Complaint Under F.R.C.P. 15(d), filed November 24, 2003	
	6.	Declaration of Katherine L. Parker in Support of Scantibodies' Reply to Nichols' Opposition to Motion for Judgment on the Pleadings and for Attorneys' Fees, filed February 23, 2004	
	7.	Supplemental Expert Report of Larry W. Evans Pursuant to Rule 26(A)(2)(B), Fed. R. Civ. P.	
	8.	Supplemental Expert Report of L. J. Defetos, MD, JD, LLM	
	9.	Expert Report of Joseph O. Falkinham, III, Ph.D. Adopting Supplemental Expert Report of L. J. Defetos, MD, JD, LLM	
	10.	Rebuttal Expert Report of Joseph O. Falkinham, III, Ph.D.	
	11.	Rebuttal Expert Report of Ellen S. Vitetta, Ph.D.	

^{*}EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
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sd-258244